

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed April 18, 2006. At the time of the Office Action, Claims 1-48 were pending in the Application. Applicant cancels Claims 41 and 42, without prejudice or disclaimer. Applicant amends Claims 1, 14, 27, and 40 without prejudice or disclaimer. The amendments and cancellations to these claims are not the result of any prior art reference and, thus, do not narrow the scope of any of the claims. Furthermore, the amendments are not related to patentability issues and only further clarify subject matter already present. All of Applicant's amendments have only been done in order to advance prosecution in this case. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 112 Rejection

The Examiner rejects Claims 27-39 under 35 U.S.C. §112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Applicant has amended independent Claim 27 to correct the antecedent basis issue identified by the Examiner.

Section 103 Rejections

The Examiner rejects Claims 1-40, 43-44, and 48 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,529,491 issued to Chang et al. (hereinafter "*Chang*") in view of U.S. Patent No. 6,167,268 issued to Souissi et al. (hereinafter "*Souissi*"). The Examiner rejects Claims 41 and 42 under 35 U.S.C. §103(a) as being unpatentable over *Chang* in view of *Souissi* as applied to Claim 40 above and in further view of U.S. Patent No. 6,246,875 issued to Seazholtz, et al. (hereinafter "*Seazholtz*"). The Examiner rejects Claim 45 under 35 U.S.C. §103(a) as being unpatentable over *Chang* in view of *Souissi* as applied to Claim 40 above and in further view of U.S. Patent No. 5,613,199 issued to Yahagi (hereinafter "*Yahagi*"). The Examiner rejects Claim 46 under 35 U.S.C. §103(a) as being unpatentable over *Chang* in view of *Souissi* as applied to Claim 40 above and in further view of U.S. Patent No. 6,115,582 issued to Ishida (hereinafter "*Ishida*"). The Examiner rejects Claim 47 under 35 U.S.C. §103(a) as being unpatentable over *Chang* in view of *Souissi* as

applied to Claim 40 above and in further view of U.S. Patent No. 6,278,877 issued to Brederveld et al. (hereinafter "*Brederveld*").

The Applicant has amended independent Claim 40 to incorporate dependent elements found in Claims 41 and 42. The Applicant also has amended independent Claims 1 and 27 to incorporate limitations similar or analogous to those found in Claims 41 and 42. Claim 14 recites a "means for electing whether or not to camp onto the specified network," and therefore also incorporates these limitations by operation of 35 U.S.C. § 112 p. 6.

The Applicant respectfully reminds the Examiner that "identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention." *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000). The examiner may not evaluate the invention "part by part," using the invention as a "roadmap to find its prior art components." *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1337 (Fed. Cir. 2005).

Accordingly, there must be some motivation, suggestion or teaching of the desirability of making the specific combination to establish obviousness based on a combination of the elements disclosed in the prior art. *Princeton Biochemicals*, 411 F.3d at 1337; *Kotzab*, 217 F.3d at 1370; accord United States Patent & Trademark Office, *Manual of Patent Examining Procedure* § 2143.01 (8th ed. rev. 2 2004) [hereinafter *MPEP*]. The teaching, suggestion, or motivation must be found either explicitly or implicitly in the references themselves, in the nature of the problem to be solved, or in the knowledge generally available to one of ordinary skill in the art. *Beckson Marine v. Nfm, Inc.*, 292 F.3d 718, 728 (Fed. Cir. 2002) (citing *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998)). It is the duty of the examiner to identify the source of the motivation, and to explain why the combination of the teachings is proper. *Rouffet*, 149 F.3d at 1356-57; *In re Fitch*, 972 F.2d 1260, 1266 ("The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification"). Hindsight reconstruction is impermissible. *Id.*

Moreover, an alleged suggestion or motivation to modify the teaching of the prior art must be supported by *particular findings and substantial evidence*. *Kotzab*, 217 F.3d at 1370 & 1371. Substantial evidence is something less than the weight of the evidence but more

than a mere scintilla of evidence. *Kotzab*, 217 F.3d at 1369. Broad conclusory statements of suggestion or motivation standing alone are not “evidence.” *Id.* at 1370.

Here, the Examiner has provided only broad, conclusory statements regarding the motivation or suggestion to modify the cited references in a manner that would render obvious independent Claims 1, 14, 27, and 40. The Examiner has failed to provide particular findings or substantial evidence to support the alleged suggestion to modify the teachings of the prior art. Accordingly, independent claims 1, 14, 27, 40, and their respective dependents are allowable over the cited references because the Examiner has failed to establish a *prima facie* case of obviousness.¹

¹ For purposes of this Office Action only, the Applicant assumes *arguendo* that the Examiner correctly argues that the prior art teaches each of the Applicant’s claimed limitations, but reserves the right to traverse these findings on appeal or in future Office Actions.

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CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant believes no fee is due. If this is not correct, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact its attorney, Thomas J. Frame, at (214) 953-6675.

Respectfully submitted,
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